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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,816	03/30/2000	James B. Armstrong	533/054	7812

26291 7590 08/14/2003

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EXAMINER

DEMICO, MATTHEW R

ART UNIT	PAPER NUMBER
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2697

8

DATE MAILED: 08/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/538,816

Applicant(s)

ARMSTRONG ET AL.

Examiner

Matthew R Demicco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. This Office Action is responsive to an amendment received 05/30/03. Claims 1-15 are pending. Claims 1, 2, 4, 6, 9, 10, 12 and 13 have been amended. The Examiner hereby withdraws the objections to the drawings and specification in view of the amendment. The Examiner hereby withdraws the 35 U.S.C. 112 rejection of Claim 4 in view of the amendment.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Patent Application No. WO 98/48566 to Mankovitz in view of U.S. Patent No. 5,729,280 to Inoue et al.

Regarding Claim 1, Mankovitz discloses an interactive information system including information consumer equipment (See Figure 1). In such a system, it is inherent that there must be provider equipment. Also taught is a method for use in an information

server wherein a primary content stream is provided to an information consumer ("Television Signal," Page 5, Line 25) and in response to a pause command received from the consumer (Pages 7-8, Lines 30-5 and "Pause," Page 8, Line 34) the primary content stream provided to the consumer is halted while simultaneously being stored in memory for later use and a second content is provided to the consumer (See Figure 2). What is not disclosed, however, is a system wherein the primary content stream is a video-on-demand (VOD) stream. Inoue discloses a video signal receiver (See Figure 1) adapted to allow the user to request the reception and display (Col. 5, Lines 18-20) of video-on-demand programming (Col. 5, Lines 28-32). Further, Inoue discloses recording the primary content stream (Col. 6, Lines 25-32) during use of a pause function (Col. 5, Line 59). During the pause, the program may continue to be displayed, or another program (secondary content) may be received and displayed (Col. 6, Lines 29-32). Inoue is evidence that ordinary workers in the art would appreciate the ability to implement video-on-demand streaming in a television system with a pause function displaying a secondary program stream and a recording memory buffer for recording the primary stream. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Mankovitz with the video-on-demand of Inoue in order to offer users the ability to request and view program content at any time to increase revenue.

Regarding Claim 2, Mankovitz in view of Inoue disclose a method as stated above in Claim 1. Further, Mankovitz discloses restarting the providing of the primary content stream to the consumer in response to a resume command received from the consumer

(Page 8, Lines 6-7). The primary content stream could be a VOD stream as disclosed by Inoue as stated above.

Regarding Claim 4, Mankovitz in view of Inoue disclose a method as stated above in Claim 1. Further, Mankovitz discloses a secondary advertisement content stream (Page 5, Lines 17-18) in the form of an Internet web page (Page 5, Lines 32-36) provided to the consumer based on program-related merchandise or any other text regarding the television program. This reads on the content stream being determined with respect to the segment of the first VOD content stream being presented to the consumer contemporaneous to the pause command.

Regarding Claim 6, Mankovitz in view of Inoue disclose a method as stated above in Claim 1. Mankovitz further discloses determining the last scene of the primary content being provided to the information consumer when the stream is halted (Page 7, Lines 35-37) by outputting the last frame of video to the signal-processing unit for extended display. Secondary content associated with the determined scene (Page 8, Lines 27-35) which is associated with at least one secondary content stream (Internet web page) is selected and provided to the consumer in response to a pause command as stated above in Claim 1. The primary content stream could be a VOD stream as disclosed by Inoue as stated above.

Regarding Claim 7, Mankovitz in view of Inoue disclose a method as stated above in Claim 1. Mankovitz further discloses that the secondary content comprises advertising content (Page 5, Lines 16-20).

Regarding Claim 8, Mankovitz in view of Inoue disclose a method as stated above in Claim 1. The secondary content in the invention of Mankovitz may be a web page (Page 5, Lines 23-24) displayed on an Internet web browser (Page 6, Lines 10-36). It is inherent in such a web browser environment that there be an "applet" or controlling program (browser) which comprises a video layer, and control layer, and a graphics layer wherein the video layer provides images associated with the secondary content (web page), the control layer enables the graphics layer to be used for selectively emphasizing and de-emphasizing portions of the video layer imagery in response to user interaction such as highlighting hyperlinks (See Figure 2).

5. Claims 3, 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz in view of Inoue and further in view of U.S. Patent No. 5,724,521 to Dedrick.

Regarding Claim 3, Mankovitz in view of Inoue disclose a method as stated above in Claim 1. What is not disclosed, however, is providing secondary content to the consumer that is determined with respect to a demographic profile associated with the consumer. Dedrick discloses a method of providing targeted secondary content in an interactive video distribution system wherein the secondary content is provided to the consumer based on a demographic profile associated with the consumer (Col. 8, Lines 17-30). Dedrick is evidence that ordinary workers in the art would appreciate the benefits of being able to target secondary content based on a demographic profile in an interactive information distribution system. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the interactive information distribution method of Mankovitz in view of Inoue with the demographically

targeted secondary content of Dedrick in order to enhance consumer exposure to information in a best-fit pricing manner.

Regarding Claim 5, Mankovitz in view of Inoue disclose a method as stated above in Claim 4. What is not disclosed, however, is providing secondary content to the consumer that is additionally determined with respect to a demographic profile associated with the consumer. Dedrick discloses a method of providing targeted secondary advertising content in an interactive video distribution system wherein the secondary advertising content is provided to the consumer based on a demographic profile associated with the consumer (Col. 8, Lines 17-30). Dedrick is evidence that ordinary workers in the art would appreciate the benefits of being able to target advertising content based on a demographic profile in an interactive information distribution system. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the interactive information distribution method of Mankovitz in view of Inoue with the demographically targeted secondary advertising content of Dedrick in order to enhance consumer exposure to information in a best-fit pricing manner.

Regarding Claim 9, Mankovitz in view of Inoue disclose a method as stated above in Claim 7 wherein the segment of the advertising content stream is presented to the user contemporaneous to the pause command. What is not disclosed, however, is providing secondary content to the consumer that is determined with respect to a demographic profile associated with the consumer. Dedrick discloses a method of providing targeted secondary advertising content in an interactive video distribution system wherein the

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secondary advertising content is provided to the consumer based on a demographic profile associated with the consumer (Col. 8, Lines 17-30). Dedrick is evidence that ordinary workers in the art would appreciate the benefits of being able to target advertising content based on a demographic profile in an interactive information distribution system. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the secondary information presentation method of Mankovitz in view of Inoue with the demographically targeted secondary advertising content of Dedrick in order to enhance consumer exposure to information in a best-fit pricing manner.

6. Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick in view of Mankovitz and further in view of Inoue.

Regarding Claim 10, Dedrick discloses an interactive information distribution system including provider equipment and subscriber equipment (See Figure 1). A head-end controller for interacting with subscriber equipment is shown in Figure 2. A video server is disclosed that provides content streams responsive to the head-end controller ("Regional Content Server", See Figure 1). It is inherent in such a system that the video server must supply primary content as well as the secondary, targeting advertising content. Further, a transport processor is disclosed ("Metering Server", See Figure 1) for communicating content to the subscriber equipment via a distribution network. An advertisement manager is disclosed (See Figure 3) that is responsive to the head-end controller for providing secondary content. What is not disclosed, however, is the head



end controller, in response to a pause command received from the subscriber equipment, causing the advertisement manager to provide secondary content to the transport processor for communication to the subscriber. Mankovitz discloses an apparatus for distributing information in an interactive environment where in response to a pause command received from the consumer (Pages 7-8, Lines 30-5 and "Pause," Page 8, Line 34) the primary content stream provided to the consumer is halted and secondary content is provided to the consumer (See Figure 2). Mankovitz is evidence that ordinary workers in the art would recognize the benefits of being able to pause a first content stream and having a second advertising stream displayed. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the secondary advertising content distribution server with advertising manager and transport processor of Dedrick with the pausing of the primary content to display the secondary content of Mankovitz in order to target ads to consumers without interrupting the primary program stream. What Dedrick in view of Mankovitz do not disclose, however, is a system wherein the primary content stream is a video-on-demand (VOD) stream. Inoue discloses a video signal receiver (See Figure 1) adapted to allow the user to request the reception and display (Col. 5, Lines 18-20) of video-on-demand programming (Col. 5, Lines 28-32). Further, Inoue discloses recording the primary content stream (Col. 6, Lines 25-32) during use of a pause function (Col. 5, Line 59). During the pause, the program may continue to be displayed, or another program (secondary content) may be received and displayed (Col. 6, Lines 29-32). Inoue is evidence that ordinary workers in the art would appreciate the ability to implement video-on-demand streaming in a

television system with a pause function displaying a secondary program stream and a recording memory buffer for recording the primary stream. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Dedrick in view of Mankovitz with the video-on-demand of Inoue in order to offer users the ability to request and view program content at any time to increase revenue.

Regarding Claim 11, Dedrick in view of Mankovitz and further in view of Inoue disclose an apparatus as stated above in Claim 10. Dedrick discloses providing targeted secondary content to the based on a demographic profile associated with the consumer (Col. 8, Lines 17-30).

Regarding Claim 12, Dedrick in view of Mankovitz and further in view of Inoue disclose an apparatus as stated above in Claim 10. Mankovitz discloses an apparatus wherein the secondary content provided to the subscriber is determined with respect to temporal segments of the content halted by the subscriber. The secondary content data is transmitted chronologically throughout the program and is accessible upon pausing the primary content (Page 8, Lines 26-28). Therefore, upon pausing the primary content, the most recent embedded secondary data pointer will be available which is most closely related to the halted content.

Regarding Claim 13, Dedrick in view of Mankovitz and further in view of Inoue disclose an apparatus as stated above in Claim 12. Mankovitz further discloses that the primary content is divided into a plurality of temporal portions, each with an associated

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secondary content (Page 8, Lines 26-35). The primary content stream could be a VOD stream as disclosed by Inoue as stated above.

Regarding Claim 14, Dedrick in view of Mankovitz and further in view of Inoue disclose an apparatus as stated above in Claim 13. Both systems of Dedrick and Mankovitz disclose the secondary content comprising advertising.

Regarding Claim 15, Dedrick in view of Mankovitz and further in view of Inoue disclose an apparatus as stated above in Claim 10. Dedrick further discloses providing targeted secondary advertising content to the consumer based on a demographic profile associated with the consumer (Col. 8, Lines 17-30).

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R Demicco whose telephone number is (703) 305-8155.

The examiner can normally be reached on Mon-Fri, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5359 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.



mrd  
July 30, 2003



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